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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,188	07/30/2003	Hiroshi Tokuda	08011.007	9228
<div>7590 Christopher J. Fildes Fildes &amp; Outland, P.C. Suite 2 20916 Mack Avenue Grosse Pointe Woods, MI 48236</div>			<div>EXAMINER L.E. HUNG CHARLIE</div> <div>ART UNIT 3663</div> <div>PAPER NUMBER</div>	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/02/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/630,188	Applicant(s) TOKUDA, HIROSHI	
	Examiner Hung C. Le	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 - 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5 is/are rejected.
- 7) ☒ Claim(s) 3, 4 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1 – 6 (Claims 7 – 15 were cancelled by applicant) have been considered but are moot in view of the new ground(s) of rejection.

### ***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claim 5 is rejected under 35 USC 101 as the claimed invention is directed to non-statutory subject matter: Based on the theory that the claim is directed to neither a "method" nor a "apparatus" but rather embraces or overlaps two different statutory classes of invention set forth in 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551 (See MPEP 2173.05 (p).II). The following steps in claim 5 which are related to the method as opposed to the claimed apparatus: "... steps of drawing and excising are conducted to a flat portion of said door inner panel by said press working of the upper and lower dies, whereas a step of excising is conducted to a side- face portion of the door inner panel by said side-face press working of the side-face working apparatus and the lower die". "Step" is related to a process not an apparatus.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 5:

The term "...steps of drawing and excising are conducted to a flat portion of said door inner panel by said press working of the upper and lower dies, whereas a step of excising is conducted to a side-face portion of the door inner panel by said side-face press working of the side-face working apparatus and the lower die" is essential method steps in an apparatus claim. Therefore it makes the claim indefinite.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2 & 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Usui et al. (US 6,530,255 B1)

With respect to claim 1:

Usui et al. disclose: A compound press-forming apparatus (40, Fig. 2) including an upper die (43) fixed to an elevated-side portion of a press machine that is moved up and down by an elevator (44), a lower die (47) fixed to a fixed-side portion of the press machine, and working portions formed at respective corresponding portions

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of the upper and lower dies (43 & 47) to conduct press working to a work (49)

jointly, comprising:

a side-face working apparatus (50 & 55) that is disposed at a side of said lower die (47) on the fixed-side portion of the press machine to conduct side-face press working to a side-face portion (49a & 49b) of the work (49) jointly with the lower die (47),

wherein said side-face working apparatus comprises a "rotating" base (52, 57, Per Webster's definition of "rotating" is performing an act or operation in turn, which 52 & 57 performing the same functions) that is supported on the fixed-side portion of the press machine so as to rotate thereon, a reciprocating base (53, 58) that is supported on said rotating base (52, 57) so as to reciprocate thereon, a side-face working portion that is formed at an end portion of said reciprocating base (53, 58) to conduct side-face press working to the side-face portion of the work jointly (49) with said lower die (47), and reciprocating driving means (51 & 52 & 53, 56 & 57 & 58) for moving said reciprocating base (53, 58) from an original position, in which said side-face working portion is away from the work, to a side-face press working position, in which the side-face press working is conducted to the work by said side-face working portion, and

said side-face working apparatus (50, 55) is constituted such that it moves to an avoidance position, in which the side-face working apparatus is not in the way of the upper die (43) going up and down, during said press working by the upper and lower dies (43, 47), whereas it moves to a working capable position, in which said side-

face press working is capable, after the upper die (43) goes up, during said side-face press working by the side-face working portion and the lower die (47) (These are essential method steps which the apparatus 50 & 55 being capable to perform the same functions).

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

With respect to claim 2:

Usui et al. further disclose: wherein said side-face working apparatus (50, 55) is constituted so as to move between said avoidance position and said working capable position according to the rotation of said rotating base of the side-face working apparatus (Fig. 2).

With respect to claim 5:

Usui et al. further disclose: wherein said work to be conducted by the press working is a door inner panel for vehicles (Fig. 7), steps of drawing and excising are conducted to a flat portion of said door inner panel by said press working of the upper and lower dies (43 & 47), whereas a step of excising is conducted to a side-face portion of the door inner panel by said side-face press working of the side-face

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working apparatus (50, 55) and the lower die (47) (Usui's apparatus is capable to perform these method step, also see item 4 above).

9. The statements of intended use or field of use, e.g., "for moving, it moves to an avoidance, during said press working, according to, steps of drawing and excising are conducted, to conduct press working, etc..." clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.



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10. Claim 3, 4 & 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung C. Le whose telephone number is 571-272-8757. The examiner can normally be reached on M-F: 07:30am - 05:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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HCL

02/22/07



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SUPERVISORY PATENT EXAMINER